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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/158,728	09/22/1998	STEVEN CRAIG WEIRATHER	310048-355	4296

7590 11/15/2002

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EXAMINER
CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
1772	31

DATE MAILED: 11/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-31

Office Action Summary	Application No.	Applicant(s)	
	09/158,728	WEIRATHER ET AL.	
	Examiner	Art Unit	
	Alicia Chevalier	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 October 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *282-408* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *282-408* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

NOTICE OF NON-RESPONSIVE AMENDMENT

1. The reply filed on October 16, 2002 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicant does not specify the claims which read on the elected species. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

It is noted that Applicant has canceled some of the non-elected claims in attempt to make matter moot. However, as pointed out in the restrictions requirement the facestock sheet construction alone has 11 different claimed embodiments/species of which Applicant chose A) facestock sheet, adhesive, and liner sheet, which does not read on the claims claiming tag or cardstock sheets. Furthermore, the newly added claims also fall under this restriction requirement and not all of them read on the elected species.

Applicant argues that the Examiner has not presented a reason or grounds for the statement that each species is patentably distinct. Species are specifically different embodiments of an invention and a species election is between specifically different embodiments of an invention. The Examiner has already shown the different embodiments of the different claim features in the restriction requirement. However, if Applicant is arguing that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a ***listing of all claims readable*** thereon, including any claims subsequently added.

Applicant's representative is more the welcome to call either the Examiner or her SPE to schedule an interview. The phone numbers for the Examiner and her SPE are provided below. However, Applicant's representative is advised any interview conducted before a first action on it's merits of the claims will not include a discussion of prior art, since no art has been applied to the claims.

Election/Restrictions

2. This application contains claims directed to the following patentably distinct species of the claimed invention:

Groups	Species
Facestock Sheet Construction	A. facestock sheet, adhesive, and liner sheet
	B. glossy card stock
	C. tag sheet
	D. a layer of adhesive and film layer
	E. facestock sheet, adhesive layer, and film layer (dry laminate facestock sheet construction)
	F. uncoated tag sheet
	G. cardstock sheet
	H. dry laminate facestock
	I. tag facestock
	J. non-dry laminate facestock
	K. non-tag facestock construction
Printable Media Arrangement	L. matrix, two columns
	M. business cards
	N. single piece, single material card
	O. matrix block of business cards with waste face stock sheet
Adhering	P. adhesive

Mechanism	Q. with out adhesive
Edge Configuration	R. edge opposite infeed end edge is calendared
	S. thin end and thin end calendaring
	T. infeed edge thinner than a body
	U. lead in edge calendared
	V. exposed lead in strip
Liner Sheet	W. densified bleached kraft sheet
	X. base paper sheet
Through-cut Lines	Y. frame and grid
	Z. waste border
	AA. vertical and horizontal

Note: A complete response to the restriction requirement requires a species election from each of the groups above. Furthermore, Applicant is advised that some claims have more than one group and species in it, i.e. a claim contains two different species from two different groups. If all the species from a particular claim are not chosen as the elected species the claim will be considered non-elected.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least claims 282 and 337 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Due to the complexity of the species election/restriction a telephone call was not made to request an oral election to the above restriction requirement

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139.

The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

11/6/02

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

11/12/02